

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Palmieri et al.	Docket No.:	2006P26237 US
Application No.:	10/813,604	Examiner:	WRIGHT, PATRICIA KATHRYN
Filed:	3/31/2004	Art Unit:	1797
Customer No.:	26474	Confirmation No.:	4357

For: Multipath access system for use in an automated immunoassay analyzer

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PETITION FROM RESTRICTION REQUIREMENT UNDER 37 C.F.R. §1.144

Sir:

This is a petition from the restriction requirement in the Office Action dated June 4, 2008. Reconsideration was requested in the response after final filed August 4, 2008, but did not result in the restriction requirement being withdrawn.

The Office action required restriction between the following alleged groups of claims:

- I. claims 27 – 38, drawn to a multi-path access system for use in an automated immunoassay analyzer;
- II. claims 39 – 46, drawn to a multi-path access system for use in an automated immunoassay analyzer; and
- III. claim 47, drawn to a method for moving samples in an automated immunoassay analyzer.

The Office action asserted that claims 27 – 38 were constructively elected by original presentation.

The restriction requirement in this case is improper and should be vacated. The

Office action incorrectly characterized the Groups I and II claims as combination and subcombination. To the contrary, MPEP §806.05(a) explains, “[a] combination is an organization of which a subcombination or element is a part.” Contrary to the assertion of the Office action, the invention set forth in claim 39 is not a subcombination of the invention set forth in claim 27, but rather contains all of the same components of claim 27. To wit, claim 27 requires:

A multipath access system for use in an automated immunoassay analyzer, comprising:

- (a) a transport device, comprising
 - (i) means for holding a plurality of vessels, and
 - (ii) means for moving the vessel holding means in a continuous loop,
- (b) a transfer station, comprising a means for moving vessels to and from the vessel holding means,
- (c) a programmable controller, programmed to determine an individual path along the continuous loop for each of the vessels,
wherein the determination of each path is based on a resource requirement associated with each vessel.

Claim 39 requires:

A multipath access system for use in an automated immunoassay analyzer, comprising:

- (a) a transport device, comprising
 - (i) a plurality of vessel holders each for holding a vessel, and
 - (ii) a mechanism for moving the vessel holders in a continuous loop,
- (b) a transfer station, comprising a transfer shuttle, positioned to slide in a direction perpendicular to a portion of the transporter device, for moving vessels to and from the vessel holders,
- (c) a programmable controller, programmed to determine an individual path along the continuous loop for each of the vessels,
wherein the determination of each path is based on a resource requirement associated with each vessel.

Thus, each of claims 27 and 39 requires (a) a transport device; (b) a transfer station, and (c) a programmable controller. The Office action incomprehensibly alleged that “the combination does not a (*sic*) require a transfer shuttle, positioned to slide in a direction perpendicular to a portion of the transporter device, for moving vessels to and from the vessels holders. The subcombination has separate utility such as means mix (*sic*) the sample in vessels.”

The Office action incorrectly characterizes claim 39 as a “subcombination” of claim 27, since claim 27 requires a transfer station including means for moving vessels to and from the vessel holding means, which is an analogous element to the transfer station including a transfer shuttle as required by claim 39. Thus, while claim 27 does not require a “transfer shuttle” for moving vessels to and from vessel holders, claim 27 however does require means for moving vessels to and from vessel holding means, which is an analogous functional element. Claims 27 and 39 thus are not related as combination and subcombination, but instead are both directed to analogous combinations.

Regarding the restriction of method claim 47 (Group III) from the apparatus of Groups I and II, the Office action asserted that “the apparatus of Groups I and II, as claimed can be used to practice another and materially different process which does not require the step of optimizing the path for each sample such that samples having identical resource requirements travel an equal distance around the first continuous loop as required in Group III.” This assertion is incorrect, and insufficient to support the requirement for restriction. MPEP §806.05(3) explains: “[t]he burden is on the examiner to provide reasonable examples that recite material differences.” The assertion fails to state a material difference between the method as set forth and the process as allegedly capable of being carried out by the claimed apparatus. Further, the assertion is in error because the apparatus claims set forth that the determination of each path by the programmable controller is based on a resource requirement associated with each vessel, and it thus follows that vessels with identical resource requirements would have the same paths. This is analogous to the process limitations as set forth in claim 48.

In Conclusion:

In view of the above, it is respectfully submitted that the restriction requirement has been issued in error, and should be vacated.

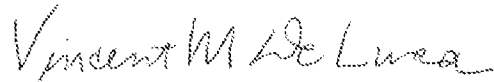
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Respectfully submitted,
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